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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/415,668	10/12/1999	HIROSHI KAIBARA	1232-4579	5143

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MORGAN AND FINNEGAN LLP  
345 PARK AVENUE  
NEW YORK, NY 10154

EXAMINER

NGUYEN, MADELEINE ANH VINH

ART UNIT PAPER NUMBER

2622

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/415,668

Applicant(s)

KAIBARA, HIROSHI

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 12-23,35-49,51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,24-34 and 50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that all groups of restricted claims are properly presented in the same application and all claims should be examined together; and examination of the claims of groups II-IV is not a burden on the examiner as examination of the claims of groups II-IV. This is not found persuasive because, as stated in the previous office action, the inventions I-IV are distinct from each others and it is a serious burden for the examiner to examine all of the claims 1-52 of groups I-IV which have acquired a separate status in the art as shown in their different classification.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-9, 24-32, 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Kunishige (US Patent No. 6,092,023).

Concerning claims 1, 24, 50, Kunishige discloses an image communication method and system (Fig. 2) comprising the steps of or means for transmitting images to an external device (36); generating a list holding information representing the transmitted images and information representing a transmission order of the images (Figs. 9-10, 12-13); and outputting the transmitted images and the order to an output device on the basis of the information held in the list (Figs.8).

It is noted that the first list in Kunishige are the images and information representing a transmission order of one cartridge of film.

Concerning claims 2-9, 25-32, Kunishige further teaches the steps of or means for storing images, selecting images to be transmitted and a transmission order, a second list (list of a plurality of different cartridges of film such as F0011, F0012, Fig.11) holding information representing the images and the transmission order selected in the selection step (the selection of any film cartridge) wherein the images are transmitted on the basis of the list generated on the second list and the first list is generated on the basis of the second list; when the image is not transmitted, information indicating that the image is not transmitted is stored in the list association with information representing the image (Fig.8); the information representing an image is the file name of the image; the transmitted images are automatically outputted in the

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transmission order (Fig.8); the output device is a display device (Fig.2), a printing device (col. 8, lines 30-41; col. 9, lines 15-20); sensing an image of an object to acquire the image (600, Fig.2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-11, 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunishige as applied to claims 1, 24 above, and further in view of Reed (US Patent No. 6,426,801).

Concerning claims 10-11, 33-34, Kunishige fails to teach that the lists are generated in accordance with a mark file format defined in CIFF. Reed discloses a high capacity computer readable medium (36 or 58, Fig. 2 or 4) for storing graphic files for printing, each comprising a digital representation of an image captured by a digital camera or scanner, wherein the graphic file format is CIFF file format (col. 6, lines 21-32). It would have been obvious to one skilled in the art at the time the invention was made to combine the teaching of the computer readable medium which can store image files formed defined in CIFF in Reed to Kunishige storage medium since the storage medium 500 in Kunishige is also a high capacity storage device (CD-ROM).

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*Conclusion*

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Moghadam et al (US Patent No. 5,799,219) discloses a system and method for remote image communications and processing using data recorded on photographic film.

b. Nihei et al (US Patent No. 6,195,513) teaches an electronic camera accessory and image composition system.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872-9314 for regular communications and 703 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.



AV  
December 24, 2002

Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2622